

### REMARKS/ARGUMENTS

The claims are 17-23 and 29-33, with claims 24-27 having been withdrawn by the Examiner as being directed to a non-elected invention. Reconsideration is expressly requested.

In the Advisory Action dated January 10, 2007, the Examiner indicated that Applicants' Amendment after final filed December 13, 2006 had been entered and had overcome the rejections under 35 U.S.C. §112, second paragraph, made in the October 19, 2006 final Office Action. The Examiner, however, maintained the rejection of claims 17-23 and 29-33 under 35 U.S.C. §103(a) as being unpatentable over *Pall et al. U.S. Patent No. 3,327,866* in view of *Halker U.S. Patent No. 4,948,658*.

The arguments presented with Applicants' December 13, 2006 Amendment were considered by the Examiner unpersuasive because in the Examiner's view (1) Halker specifically discloses that his invention is useful in a filter and therefore in the Examiner's view, there is motivation to combine *Pall et al.* with *Halker*, and (2) that one having ordinary skill in the art would have optimized the fiber diameter and fiber density motivated by the desire to create a mesh with the desired filtration properties.

This rejection is respectfully traversed.

As stated in Applicants' December 13, 2006 Amendment, there is no disclosure or suggestion in the primary reference to *Pall et al.* of a plurality of metal fiber threads worked in between metal wires or of having each fiber have a diameter of less than 100  $\mu\text{m}$  and a section through the metal fiber thread having more than 100 fibers, as recited in claim 29. A fortiori, *Pall et al.* fails to disclose or suggest a cloth or mesh wherein each fiber has a diameter less than 30  $\mu\text{m}$  and the section through the metal fiber thread has more than 500 fibers, as recited in claim 30. Although the Examiner has taken the position that one skilled in the art would have been motivated to insert metal fiber threads worked in between the metal wires of *Pall et al.* because *Halker* discloses a material for use as a filter wherein filter threads are inserted to provide the core filament, it is respectfully submitted that one skilled in the art would have no reason to do so.

Although it is correct that the strip of material in the *Halker* patent is used as a filter or as a pressing pad, it should be noted that the filter holes in the *Halker* patent are the distance between the longitudinal threads 1. Therefore, there is

a lot of space between these longitudinal threads. Consequently, the water will drop through the strip of material and the surface space of the strip of material is the area where the paper is positioned on. There is no need to filter the water using the strip with a paper machine. The web in the paper machine is for separating the water and the paper. The fibers in the longitudinal thread of *Halker* are for capillary purposes to dry the paper, not for filtering purposes.

Thus, one reviewing *Halker* would have no reason to insert such filter threads into the metal wires of *Pall et al.*, as the capillary purpose for drying the paper is irrelevant to *Pall et al.*'s filter material.

Moreover, although the Examiner implicitly recognizes that neither *Pall et al.* nor *Halker* includes the specific fiber diameter and the fiber density as recited in the claims, the Examiner instead asserts that one skilled in the art would have obtained this fiber diameter and fiber density because of a desire to create a mesh with desired filtration properties; however, it is respectfully submitted that there is no basis for the Examiner's position and certainly there is nothing in *Pall et al.* or *Halker* that would lead one skilled in the art to such optimization. In particular, there is nothing in either of these

references or in anything else pointed out by the Examiner that would lead one skilled in the art to have each fiber with a diameter less than 30  $\mu\text{m}$  and a section through the metal fiber thread having more than 500 fibers, as recited in claim 30, for example. In fact, if as the Examiner suggests one skilled in the art would have been motivated by *Halker* to insert metal fibers into the woven wire or mesh of *Pall et al.*, that person would have also been taught to have a lot of space between the longitudinal threads so that the water would drop through the strip of material, rather than using Applicants' small fibers. Contrary to the Examiner's position, it was surprising to learn that a woven fabric having fine fibers in a dense structure, as recited in Applicants' claims, would offer both sufficient stability and strength for filter systems, yet can also function as a screen material.

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art...." 35 U.S.C. 103 (a). As instructed by the Federal Circuit in *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), the phrase "at the time the invention was made" guards against entry into the tempting but forbidden zone of hindsight. Thus,

"Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'"

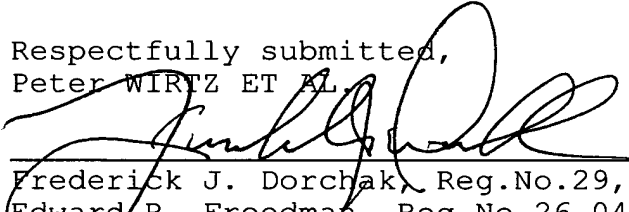
50 U.S.P.Q.2d at 1617 (citations omitted).

It is respectfully submitted that in rejecting the claims, the Examiner is engaging in an impermissible retrospective view with knowledge of the invention in that *Pall et al.* teaches the use of monofilament metal wires in the usual manner as preferred in filter tasks, see column 4, lines 70ff of *Pall et al.*, that *Halker* teaches the use of capillaries having a diameter of approximately 2000  $\mu\text{m}$  far in excess of the thickness of Applicants' fibers, that one skilled in the art would not use anything taught by *Halker* to insert metal fiber threads in between metal wires in *Pall et al.* because the fibers in the longitudinal threads of *Halker* are not for filtering purposes, and nothing taught by *Halker* would lead one skilled in the art to conclude that *Pall et al.*'s filter would benefit by the addition of such metal fiber threads. Accordingly, it is respectfully

submitted that the claims recite unobvious and patentable subject matter.

In view of the foregoing and for the reasons set forth in Applicants' Amendment filed December 13, 2006, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted,  
Peter WIRTZ ET AL.

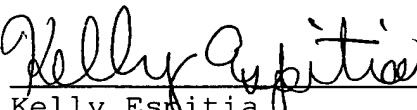
  
Frederick J. Dorchak, Reg.No.29,298  
Edward R. Freedman, Reg.No.26,048  
William C. Collard, Reg.No.38,411  
Attorneys for Applicant

COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Roslyn, New York 11576  
(516) 365-9802

**EXPRESS MAIL NO. EV 956 231 543 US**

**Date of Deposit: January 17, 2007**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date indicated above, and is addressed to the Commissioner for Patents, U.S. PTO, Mail Stop RCE, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Kelly Espitia